

### **REMARKS**

Claims 11, 12, and 14-19 remain pending in this application. Claims 11 and 16 are independent. Claims 11 and 16-18 have been amended, and no claims have been added or canceled by this amendment.

### **Indefiniteness Rejection**

Withdrawal of the rejection of claims 17-18 under 35 U.S.C. §112, second paragraph, as being indefinite, is requested. These claims have been amended in a manner that is believed to overcome the stated bases for indefiniteness. No new matter is involved with this claim amendment.

### **Anticipation Rejection by Adams**

Withdrawal of the rejection of claims 11-15 under 35 U.S.C. §102(b) as being anticipated by Adams (US 2,112,007)) is requested. Claim 13 has been canceled and incorporated into independent claim 11.

Applicant notes that anticipation requires the disclosure, in a prior art reference, of each and every limitation as set forth in the claims.<sup>1</sup> There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. §102.<sup>2</sup> To properly anticipate a claim, the reference must teach every element of the claim.<sup>3</sup> “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”.<sup>4</sup> “The identical invention must be shown in as complete detail as is contained in the ...claim.”<sup>5</sup> ***In determining anticipation, no claim***

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<sup>1</sup> *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985).

<sup>2</sup> *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991).

<sup>3</sup> See MPEP § 2131.

<sup>4</sup> *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

<sup>5</sup> *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

***limitation may be ignored.***<sup>6</sup> With respect at least to independent claim 11, the applied art fails to meet this threshold requirement.

### ***Discussion of Adams***

The Examiner asserts with reference to Fig. 1 that Adams discloses that the element comprises a homogeneous material. As the examiner has not made a feature-by-feature comparison of the claim limitations with the applied art, Applicants are unable to make a determination of which specific features of Adams that the Examiner discloses the various limitations of the claims.

However, a principal difference between the claimed invention and Adams is that the seat wall is free of intermediate layers of material compositions and material alterations, and has homogenous material strength (e.g., claims 12-15).

One possible interpretation of Adams is that socket 18 forms a seat, as the socket enables the support element to be applied to the implants. If so, then Adams does not disclose that the seat and the surrounding material have the same material strength.

Another interpretation of Adams is that the structural elements of Adams enabling the support element to be applied to implants are the socket and the recess formed in the plate, and which surrounds the socket. It is the recess that penetrates the surface of the plate, and the socket that enables the support element to be applied to the implants. If this is the interpretation, then the socket disclosed in Adams does not disclose that the seat and the surrounding material have the same material strength.

To summarize, it appears that one difference between the claimed invention and Adams is that Adams uses the socket to provide a seat for the implant, whereas the seat is formed directly in the element according to the invention.

Independent claim 11 has been amended to clarify this particular feature of Applicants' claimed invention.

In particular, the applied art does not disclose an elongate support element suitable for

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<sup>6</sup> *Pac-Tex, Inc. v. Amerace Corp.*, 14 USPQ2d 187 (Fed. Cir. 1990) (emphasis added).

use with implants and as a replacement structure for the human body wherein, among other features, "...a material strength around each of the plural seats has essentially a same material strength as a remaining portion of the support element material", as recited in independent claim 11, as amended.

Since the applied art does not disclose all the recited limitations, withdrawal of the rejection and allowance of independent claim 11, and dependent claims 12, 14, and 15, depending therefrom, are requested.

**Unpatentability Rejection over Willoughby in View of Adams**

Withdrawal of the rejection of claims 16-19 under 35 U.S.C. §103(a) as being unpatentable over Willoughby (US 5,873,721) in View of previously cited Adams is requested.

At the outset, Applicant notes that, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference must teach or suggest all the claim limitations.***<sup>7</sup> Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.<sup>8</sup>

The Examiner asserts that Adams teaches that center axes of recesses are non-parallel with each other.

Whether or not that is true, the applied art, taken alone or in combination, does not teach or suggest a method for producing and installing a tooth replacement structure, which includes, among other features "...ensuring that a material strength around each of the seats has essentially a same material strength as the support part", as recited in independent claim 16, as amended.

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<sup>7</sup> See MPEP §2143.

<sup>8</sup> *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and See MPEP §2143.

Since the applied art does not disclose all the recited limitations, withdrawal of the rejection and allowance of independent claim 16, and dependent claims 17-19, depending therefrom, are requested.

**Conclusion**

In view of the above amendment and remarks, applicant believes that each of pending claims 11, 12, and 14-19 in this application is in immediate condition for allowance.

In the event the Examiner believes that an interview would be helpful in resolving any outstanding issues in this case, the undersigned attorney is available at the telephone number indicated below.

For any fees that are due, including fees for extensions of time, please charge CBLH Deposit Account No. 22-0185, under Order No. 21547-00287-US from which the undersigned is authorized to draw.

Respectfully submitted,

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